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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/723,358      | 11/26/2003  | Bill Thomas Brazil   | BTB-002             | 9550             |
| 7590            | 07/28/2005  |                      |                     |                  |
| EXAMINER        |             |                      |                     |                  |
| THOMAS, DAVID B |             |                      |                     |                  |
| ART UNIT        |             |                      | PAPER NUMBER        |                  |
| 3723            |             |                      |                     |                  |

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,358

Applicant(s)

BRAZIL, BILL THOMAS

Examiner

David B. Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
|---|--|

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the polymers and polymeric coatings, as admitted by the applicant in the specification, in view of Villanyi (4,520,542).

Villanyi ('542) discloses a tool for installing pistons which compresses the piston rings. Villanyi ('542) recognizes several problems in the installation of pistons in an IC engine, including, but not limited to damaging the piston rings, and thus teaches that it would be desirable to provide a coating (Villanyi relies upon chrome plating) on the piston ring compressor in order to reduce the possibility of damaging the piston rings. Thus, based upon the teachings of the applicant's admitted prior art with respect to the various polymers, the examiner respectfully contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have taken the teaching from the prior art with respect to these polymers and applied it to a piston ring compressor, as Villanyi ('542) teaches that it would be desirable to provide a low friction coating on a piston ring compressor in order to reduce the possibility of damaging the piston ring during installation.

***Response to Arguments***

3. Applicant's arguments filed June 28, 2005 have been fully considered but they are not persuasive. The present application is drawn to the application of a known

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coating material, e.g. the various polymeric compositions as disclosed, to the various working surfaces of a variety of known tools. Due to an election of species requirement, the applicant chose to specifically prosecute the claims directed to a piston ring compressor having the known coating material. As such, the examiner looked to the prior art with respect to piston compressors. During the search, the examiner found, as well as cited a reference to Erwin (US 20040035259 A1), who discloses a wrench and teaches the provision of a non-metallic coating to reduce slippage and to protect the workpiece from damage. The coating material may be, for example, rubber, plastic, polymer, or elastomer; or could be polyolefin, polyurethane, polyvinyl chloride, or Teflon. The examiner did not apply this reference because it did not explicitly apply to piston ring compressors.

However, in response to the applicant's arguments, the examiner contends that Erwin must be considered for its teachings with respect to tools in general, the coating of the work surfaces of a tool, as well as being evidentiary of coatings that may be rubber, plastic, polymer, or elastomer; or could be polyolefin, polyurethane, or polyvinyl chloride. Erwin teaches that the purpose of the coating is to protect the workpiece from being damaged by the tool. The examiner has relied upon Villanyi for the specific teaching of the application of *a coating on a piston ring* compressor..." The tool has a self-closing lock to lock the tool in the **piston ring compressing** configuration and *the tool has a coated tapered bore* through which the **piston and piston** rings pass when being installed into the **piston** cylinder bore of the engine block via a closed tool." (Col. 4, lines 36-41)...and..."the surface 44 is coated to reduce piston ring friction and surface wear,

and is preferably chrome plated. The taper of surface 44 of jaw portions 12 and 14 causes piston rings seated on a piston being advanced through a closed tool to be gradually compressed as a piston assembly is moved into an engine block cylinder bore liner through tool 10. The length of the tapered section of a closed tool 10, as measured from the entrance section rim 48 to the shoulder 50, as well as the diameter defined by the tapered section at any location thereon, is selected to establish proper piston ring compressing force against a surrounded piston ring while permitting movement of the piston assembly into the entranceway 46, through the closed tool 10, then to and through the exit section 32 of the tool 10" (Col. 5, lines 45-59).

Therefore, in view of the evidence that the polymer coatings are known coating materials, that Villanyi specifically teaches the application of a *coating on a piston ring* compressor, and that Erwin further provides evidence of polymeric coatings being applied to a tool, the examiner, respectfully contends that it would have been obvious to have "modified" the piston ring compressor of Villanyi by coating the compressor with a known polymeric coating, rather than being limited to "chrome plating", where the substitution of one known coating material for another known coating material would be within the level of ordinary skill of a tool artisan.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. Thomas whose telephone number is (571) 272-4497. The examiner can normally be reached on 7-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David B. Thomas  
Primary Examiner  
Art Unit 3723